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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GART, MATTHEW S

ART UNIT

PAPER NUMBER

3625

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/759,534

Applicant(s)

ISHIZUKA ET AL.

Examiner

Matthew S. Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/29/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3,4,12,14,16,20,22-26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,4,12,14,16,20,22-26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/4/7</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

- Claims 3-4, 12, 14, 16, 20, 22-26 and 28-29 are pending and under consideration.

Claim Objections

Referring to claims 3-4, 12, 14, 16, 20, 22-26 and 28-29. The claims are objected to because they are replete with grammatical and structural informalities. An exemplary list of a few of said informalities is set forth below.

Claim 1: It is unclear if the second option is being displayed along with the first option.

Claim 12: The preamble recites, "...a commodity sale transaction site on Internet..." This language is grammatically incorrect.

Claim 14: The preamble recites, "...executing a transaction via Internet..." This language is grammatically incorrect.

Claim 25: The claim recites, "...where the usage information is stored correspondingly with respective specification information..." The Examiner is unclear of the meaning of the term "correspondingly" within the context of the claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Referring to claims 3-4, 12, 14, 16, 20, 22-26 and 28. The claims are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- The specification as originally filed does not provide adequate support for the displaying of a first option along with the displaying of a second option as required by the amended claims.
- The specification as originally filed does not provide adequate support for, "...retrieving and displaying data regarding a commodity having specifications corresponding to the usage information selected subsequent to a user's selection of the usage information via the first option without requiring the user's knowledge of the specifications."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-4, 12, 14, 16, 20, 22-26 and 28-29 are rejected under 35

U.S.C. 102(e) as being anticipated by Puri (U.S. Patent No. 6,064,982).

Referring to claim 3. Puri discloses a commodity retrieval method in a commodity sale transaction via a network (Puri: FIG. 1, "12"), the method comprising:

- Storing a table indicative of correspondence between the objects of use (Puri: FIG. 4, "52") and necessary specifications (Puri: FIG. 4, "50") required for commodities (Puri: FIG. 5, "60");
- Displaying a first option indicating the objects of use identifying specific operations implemented by the commodities on a user's terminal with a second option listing the specifications of said commodities (Puri: Fig. 4-6).
- Acquiring a specification (Puri: FIG. 4, "50") corresponding to at least one object of use (Puri: FIG. 4, "52") selected by a user (Puri: FIG. 4, "51") using the first option based on said correspondence stored in the table, said acquiring being

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subsequent to selection of the at least one object of use indicating a desired operation from the displayed objects of use of the commodities (Puri: FIG. 4);

- Retrieving a commodity based on the acquired specification as a retrieval condition (Puri: FIG. 5, "60"); and
- Displaying, on the terminal, information of the commodity having the specification corresponding to the selected object of use without requiring the user's knowledge of specification corresponding to the at least one object of use selected by the user, where said information of the commodity is retrieved using the specification as the retrieval condition responsive to direct selection from said second option (Puri: FIG. 6).

Referring to claim 4. Puri further discloses a method wherein the network is Internet (Puri: column 2, line 61 through column 3, line 9).

Referring to claim 12. Claim 12 is rejected under the same rationale as set forth above in claims 3-4.

Referring to claim 14. Claim 14 is rejected under the same rationale as set forth above in claims 3-4.

Referring to claim 16. Claim 16 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 20. Claim 20 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 22. Claim 22 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 23. Claim 23 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 24. Claim 24 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 25. Claim 25 is rejected under the same rationale as set forth above in claims 3.

Referring to claim 26. Puri discloses a commodity retrieval method for a commodity sales transaction, comprising:

- Storing attribute information of commodities available for sale and displaying an object of use identifying specific operations implemented of the commodities for sale based on the stored attribute information, the object of use corresponding to necessary specifications required for the commodities (Puri: FIG. 4); and

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- Enabling a user to make a selection from the displayed object of use (Puri: FIG. 4, "51") and providing information of a corresponding commodity to the user based on the selection of a desired operation from said specific operations implemented by the commodities (Puri: FIG. 5).

Referring to claim 28. Puri discloses a commodity retrieval method, comprising:

- Determining a commodity meeting a need of a user in response to a selection from operations implemented by components of commodities by the user (Puri: FIG. 4 and FIG. 5); and
- Retrieving a list of commodities matching a desired operation selected from said operations by the user and allowing the user to select a commodity from the list (Puri: FIG. 5, "60" and column 5, lines 26-48).

Referring to claim 29. Claim 29 is rejected under the same rationale as set forth above in claims 3.

Response to Arguments

Applicant's arguments with respect to all the pending claims have been considered.

The Applicant argues that that Puri does not disclose, "...retrieving and displaying data regarding a commodity having specifications corresponding to the usage information selected subsequent to a user's selection of the usage information via the first option without requiring the user's knowledge of the specifications."

The Examiner notes, this language is not supported by the specification as originally filed. The proscription against the introduction of new matter in a patent application (35 U.S.C.132 and 251) serves to prevent an applicant from adding information that goes beyond the subject matter originally filed. See *In re Rasmussen*, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). See MPEP § 2163.06 through § 2163.07 for a more detailed discussion of the written description requirement and its relationship to new matter.

The Examiner notes, the claims as amended have been mapped in detail to the Puri reference as set forth above.

The Examiner further notes, by definition a table is data arranged in either rows or columns. Using Fig. 4 of Puri, a customer may select among various statements 50 (specifications) by checking a box 51 associated with each statement. The identification page also includes various links to other topics (objects of use), which may be selected to bring up additional statements (specifications). In this way, the process may be

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thought of as being hierarchical, i.e. as generalized statements (objects of use) are selected the smart configurator suggests more specific statements (specifications) until the objects of use are thoroughly and accurately assessed. The objects of use and the specifications are arranged horizontal to each other forming a table.

FIG. 5 of Puri is an illustration of a commodity choice page for the smart configurator of FIG. 1. This commodity choice page provides a list **60** of company and/or partner products.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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